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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No. 968

315-873

MASSACHUSETTS HAIR & FELT CO.,
Petitioner,
v.
B. F. STURTEVANT Company,
Respondent

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

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PETITION FOR WRIT OF CERTIORARI
to the United States Circuit Court of Appeals
for the First Circuit

To the Honorable the Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Massachusetts Hair & Felt Co., respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the First Circuit to reverse the judgment of that Court entered on September 29, 1941, rehearing denied November 21, 1941, and amended on a second rehearing December 15, 1941.

SUMMARY AND SHORT STATEMENT

The issues here relate to extension of monopoly.

Petitioner was defendant in the District Court where the case was referred to a master. The master reported claim 1 of the first Hagen patent, 1,846,863, invalid, and claim 2 valid and infringed, and reported the second Hagen patent, 1,989,413, invalid. This report was confirmed by the District Court.

The Circuit Court of Appeals for the First Circuit affirmed the District Court with respect to the first Hagen patent and reversed it with respect to second Hagen patent, holding claim 1 of the first patent invalid and claim 2 valid and infringed, and holding all claims of the second patent valid and infringed.

The primary issue with respect to the first patent is the extension of monopoly by the respondent in re-patenting an admittedly old basic combination, although the only claim to invention lies in the design of one element thereof. The primary issue with respect to the second patent is the extension of the monopoly of the first patent by re-patenting the invention thereof with unpatentable additions.

Both patents in suit relate to the use of adjustable vanes located at the inlet of a conventional centrifugal fan or blower to control the spin of entering air and thereby control the output of the fan. They both utilize the ancient principle of reducing output of such a fan or blower by creating, in the entering air, a spin in the direction of rotation of the rotor or impeller of the fan.

In the first patent, a series of adjustable curved vanes 26 are used to control the output of a conventional centrifugal fan which is driven in the usual way by a con-

ventional constant speed motor. These vanes are arranged around the inlet of the fan. As the vanes are moved toward closed position, the spin in the entering air is increased and the output is reduced accordingly. When the vanes are nearly closed they cause substantially all of the air to spin and produce a condition known as tangential admission (R. V. II, p. 579).

The invention patented in Claim 2 of this patent is the old combination of a constant speed motor, a centrifugal fan, having a rotor and an inlet, and a plurality of vanes in the inlet forming fluid directing passages to admit fluid to the rotor with a spin in the direction of rotation of the rotor. The vanes are the improved element. They are defined in detail as adjustable to vary output from maximum capacity to minimum capacity with substantially tangential admission of fluid and as having adjacent surfaces continuously approaching parallelism and having extended overlapping portions shaped to define passages of substantially uniform cross section as the vanes are moved toward closed position (R. V. II, p. 581).

The Master found as a fact that there is no novelty in the first portion of Claim 2 through the provision for vanes which are adjustable to vary output and that the advance of Claim 2 therefore resides in the design and arrangement of the vanes (R. V. II, pp. 110-111). He could not find otherwise because the prior patents clearly showed the old combination.

In Eickhoff 928,034 (R. V. II, p. 670) the vanes *k* control the spin of air entering a fan or blower from maximum capacity to minimum capacity with substantially tangential admission of fluid. In Moody 1,460,428 (R. V. II, p. 678) vanes 25 in Fig. 1 and 32 in Fig. 2 control spin to control output. In Beaudrey French patent 589,469

(R. V. II, p. 765) vanes 3 control output at constant speed from maximum to minimum by controlling spin. In Brown, Boveri Swiss patent 99,575 (R. V. II, p. 747) vanes 1 control spin and thereby control fan output.

The differences claimed by the respondent over these prior art patents which show the old combination are merely specific details of vane design or arrangement. The vanes *k* of Eickhoff are distinguished because they are flat instead of curved. Respondent points out that because of this the angle between their adjacent surfaces remains constant at all positions and the vanes never approach parallelism and do not define passages of substantially uniform cross section as they are moved toward closed position. The respondent contends that the Moody patent does not disclose with sufficient detail the exact shape of the vanes and that they might be stream lined, in which case they might not give tangential admission at minimum capacity, and might not approach parallelism or define passages of substantially uniform cross section. Respondent urges further that Moody does not disclose the full range of adjustment from maximum to minimum capacity. The respondent urges that Beaudrey does not anticipate because the vanes are streamlined in cross section instead of merely curved as in the first Hagen patent and that consequently there is no tangential admission at minimum capacity and the vane surfaces do not approach parallelism or define passages of uniform cross section. The respondent urges that the Brown, Boveri vanes are not disclosed with sufficient clarity and that their range of movement is not clearly defined as being from maximum to minimum and that it is not clear that the fan is operated at constant speed.

The inventive concept claimed by respondent for the first Hagen patent is the wide range of control from

maximum to minimum with tangential admission at the minimum and the more predictable, better control, said to be peculiar to vanes of the claimed design which give spin control throughout this range.

The second Hagen patent extends the monopoly of the first one by adding to it features old in the art. The basic inventive concept of the claims of this patent is the adjustment from maximum to minimum capacity, with tangential admission at the minimum, of vanes which throughout this adjustment direct the entering air to the fan rotor with an appreciable spin. These vanes are defined as being pivoted in a conical inlet on axes oblique to the rotor axis and perpendicular to the conical inlet (R. V. II, p. 588).

This particular mounting of the vanes 16 in the conical inlet 12 is shown in Fig. 2 of the patent (R. V. II, p. 586). It is identical with the optional, conical mounting of the vanes 32 described by Moody in his specification (R. V. II, p. 280, line 63 *et seq.*) which is illustrated in Exhibit MMMM (R. V. II, p. 784). There the vanes 32 are pivoted on axes oblique to the rotor axis and perpendicular to the conical inlet.

The Master's Report

The master made extensive findings in holding Claim 1 of the first Hagen patent invalid and Claim 2 valid and infringed and in holding the second patent invalid.

The master found that Hagen does not claim to have discovered the principle of spin control and that he does not claim to have invented broadly an apparatus for producing and varying spin of air entering a fan by an arrangement of adjustable vanes at the inlet (R. V. I, p. 55).

He found that Eickhoff 928,034 (R. V. II, p. 670) shows and describes vanes surrounding the inlet of a fan and adjustable to increase or decrease spin component of entering air from maximum to minimum as means for controlling output (R. V. I, p. 81) and that Eickhoff provides substantially tangential admission (R. V. I, p. 83). He found, however, that in Eickhoff the straight vanes *k* do not continuously approach parallelism or define passages of substantially uniform cross section as they are moved toward closed position (R. V. I, p. 85).

He found that Moody 1,460,428 (R. V. II, p. 678) shows vanes to control spin of the entering fluid (R. V. I, p. 87). He found, however, that it is entirely consistent with Moody's specification that the vanes be streamlined and that such vanes would not continuously approach parallelism or define passages of uniform cross section and that they would not provide tangential admission at closing (R. V. I, pp. 89-90). He found also that Moody does not clearly disclose the full range of movement claimed by Hagen (R. V. I, p. 91).

He found that Beaudrey French patent 589,469 (R. V. II, p. 765) discloses the use of vanes to impart spin at constant speed to vary output from maximum to minimum (R. V. I, p. 93). He found, however, that the vanes were streamlined and would therefore not approach parallelism or form passages of uniform cross section and that they would not give tangential admission at closing (R. V. I, p. 95). He said that the vanes of Fig. 13 of Brown, Boveri Swiss patent 99,575 (R. V. II, p. 745) were substantially identical with Hagen's vanes (R. V. I, pp. 73-4), but found that the disclosure was not adequate, that it did not clearly disclose constant speed operation or the full range of adjustment of Hagen (R. V. I, pp. 77-8).

He found that there is no novelty in the first portion of Claim 2 through the provision for vanes adjustable to vary output and found that the advance of Claim 2 resides in the design and arrangement of vanes (R. V. I, pp. 110-11).

The master found that the second Hagen patent is invalid for lack of invention. He found that Moody 1,460,428 shows the elements of the first part of the claims, namely the rotor, the casing, the conical inlet and the vanes pivoted on oblique axes, but that Moody does not show the wide range of adjustment which is common to both Hagen patents and therefore does not anticipate (R. V. I, p. 117). He found, however, that there could not be any invention in view of Hagen's first patent in arranging the vanes in the eye of a forced draft fan and making them adjustable from a wide open position through 90° to a closed position for the purpose set forth in the claims and that there could be no invention in using the old conical inlet and the oblique axes, in particular, because this particular manner of mounting vanes is described in Moody (R. V. I, p. 118).

The Decision of the District Court

The District Court confirmed the master's report. The District Court held that Eickhoff showed vanes adjustable to increase or decrease spin from maximum to minimum as means for controlling output and described the use of such vanes and that Beaudrey discloses out to control output at constant speed by supplying spin and adjusting it (R. V. I, pp. 165-6).

The District Court agreed with the master and the structures and method of mounting the vanes of the second Hagen patent does not constitute invention and that Moody discloses this type of structure and method of mounting (R. V. I, p. 168).

The Decision of the Court of Appeals

The Circuit Court of Appeals wrote two opinions and amended the second opinion. In its first opinion with reference to the first Hagen patent, it found that Hagen makes no claim to have discovered the principle of spin control or to have invented broadly the apparatus for producing and varying spin with adjustable vanes in the inlet of a fan (R. V. III, p. 799). It found that it involved invention to use Hagen's curved vanes and to adjust them through the wide range from maximum to minimum (R. V. III, p. 812). It agreed with the master's findings with reference to the prior art, reviewing them specifically. It found that the important difference between Eickhoff and the first Hagen patent is that Eickhoff uses flat vanes instead of curved ones and that flat vanes can never approach parallelism and define passages of uniform cross sectional area when moved toward closed position (R. V. III, p. 811). It found that Moody differed in the form of vane since Moody did not have vanes which would approach parallelism or define the passages of uniform cross sectional area or provide substantially tangential admission on closing. It made the same finding with reference to Beaudrey and Brown, Boveri (R. V. III, pp. 810-811).

It approved the master's finding that the advance of Claim 2 resides in the design and arrangement of the vanes.

In a petition for rehearing, petitioner pointed out that the findings that Hagen was not the inventor of the first portion of Claim 2 and that his invention resides in the design and arrangement of the vanes as specified in the last portion of Claim 2 made the decision of this court in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, applicable because in Claim 2 of the first patent Hagen claimed the old combination of the constant speed motor, the fan and vanes (R. V. III, pp. 821-2).

The Court of Appeals re-considered the matter in the light of this case and of *Bassick Mfg. Co. v. Hollingshead,* 298 U. S. 415. It held that Hagen's first patent does not claim an old combination with a new element, but only claims a new element and that these cases are therefore not in point. The court reviewed the admissions of the plaintiff and the findings of the master that the combination is old and concluded that Claim 2 was valid (R. V. III, p. 824).

Both parties then requested a reconsideration (R. V. III, p. 827). The Circuit Court of Appeals then amended the opinion by striking out the three paragraphs in which it made the above discussed findings and which appear at the top of page 824 of Vol. III and substituted a new paragraph (R. V. III, p. 828). In this new paragraph the court reverses itself, stating that Hagen's claim covers a combination. It states that the *Lincoln* and *Bassick* cases are not in point because the respondent did not attempt to prevent others from using any form of vane controlled centrifugal fan, but attempted only to prevent others from using such a fan with inlet vanes substantially similar to his.

The court said that the new form of vane caused the combination to produce a new useful result which is not the aggregate of the several results.

The Court of Appeals does not specify what new result it has in mind, but it is apparent that the court had in mind what it terms the more predictable better results attendant upon using the vanes of the first Hagen patent.

With reference to the second Hagen patent, the Court of Appeals found that the invention of the second Hagen patent was in combining the parts to give the more predictable better control over a wide range which is claimed for both Hagen patents (R. V. III, p. 815). It held that

the master and the District Court erred in holding the second patent invalid. It held that it was not necessary for the second Hagen patent to embody a patentable advance over the first Hagen patent because the applications for the Hagen patents were co-pending (R. V. III, p. 816).

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT

Petitioner believes that a writ of certiorari should be granted in this case for the following reasons and accordingly the discretionary power of this Court is invoked:

1. The Circuit Court of Appeals for the First Circuit, in holding Claim 2 of Hagen patent 1,846,863 valid over the prior art, has rendered a decision in conflict with the decisions of this Court in *Bassick v. Hollingshead,* 298 U. S. 415, and *Lincoln v. Stewart-Warner,* 303 U. S. 545, which prohibit the extension of the monopoly of an expired patent by merely substituting an improved element for the same element in an old combination.

2. The Circuit Court of Appeals for the First Circuit, in holding Hagen patent 1,989,413 valid over the prior art, has rendered a decision in conflict with the decisions of this Court in *Bassick v. Hollingshead,* 298 U. S. 415, and *Lincoln v. Stewart-Warner,* 303 U. S. 545, which prohibit the extension of monopoly by adding mechanical details old in the art to an old combination.

3. The Circuit Court of Appeals for the First Circuit, in holding that the decisions of this Court in *Bassick v. Hollingshead,* 298 U. S. 415, and *Lincoln v. Stewart-Warner,* 303 U. S. 545, are applicable only to cases in which a patentee who has re-patented an old combination with an improved element and is trying to prevent others from selling or using old elements of the combination, has ren-

dered a decision in conflict with those decisions or has raised a point of law which has not been and should be settled by this Court.

4. The Circuit Court of Appeals for the First Circuit, in holding that Hagen patent 1,989,413 is valid over Hagen patent 1,846,863 and the prior art on the ground that it is not necessary for the second Hagen patent 1,989,413 to involve a patentable advance over Hagen patent 1,846,863, because the applications were co-pending, has decided an important question of Federal Law which has not been but should be settled by this Court, and has decided it in a way contrary to an important body of decisions of far-reaching scope.

PRAYER

Wherefore, your Petitioner respectfully prays that a Writ of Certiorari be issued to the Circuit Court of Appeals for the First Circuit to the end that this cause may be reviewed and determined by this Court in accordance with principles of law heretofore announced by it and that the judgment of the Circuit Court of Appeals for the First Circuit be reversed as to the findings of validity of Claim 2 of Hagen patent 1,846,863 and of all claims of Hagen patent 1,989,413, and that Petitioner be granted such other and further relief as may be proper.

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